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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,246	02/12/2004	Kazufumi Nakamura	248922US0CONT	4192

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,246

Applicant(s)

NAKAMURA ET AL.

Examiner

Golam M M Shameem

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-5 are currently pending in the application.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 05/12/2004, which has been entered in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gee *et al* (WO 9708164) and further in view of Nasuno *et al* (WO 9625412).

Applicant claims the pyrazole derivatives of formula (I) that are useful to control cropland weeds and herbicides containing them.

Determination of the scope and content of the prior art (MPEP §2141.01)

Gee *et al* and Nasuno *et al* teach independently the analogous compounds to those instantly claimed invention having similar utility.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the claimed compounds and that of the reference herein lies in the selection of different substitutions in core benzothiophene ring of formula (I), such as an

additional alkyl (methyl) group is substituted in benzothiophene ring 3-position of the instantly claimed compound (wherein Q is a hydrogen atom) instead of hydrogen for the same position in the prior art (RN 188613-26-5, CAPLUS database, a copy is provided herewith).

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It is well established that the substitution of alkyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lohr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The disclosure of Gee *et al* and Nasuno *et al* that teach several combinations, which would easily place Applicants invention in possession of the public at the time of Applicants invention was filed. Therefore, in the instant case, one skilled in the art would be motivated to choose to replace a hydrogen atom with a methyl group or vice versa in view of the known teaching of the art. The claimed compounds are so closely related structurally to the homologous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Since the core benzothiophene ring of formula (II) is not novel and the novelty (if there is any) lies in the selection of different variable substitutions, a great caution should be exercised to determine the patentability of the claimed invention. Therefore, in looking at the instant claimed compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

The reference cited on the PTO-892 is included only to show the state of the art.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Art Unit: 1626

A handwritten signature in black ink, appearing to read "Golam M M Shameem". The signature is stylized with a large, looping initial "G" and "M".

Golam M M Shameem, Ph.D.
Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1

August 30, 2004